

(i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C; ^{68.1°C}

(ii) from about 5 to about 90% of one or more immobilizing agents capable of immobilizing said emollient on said outer surface of the topsheet, said one or more immobilizing agents having a melting point of at least about 35°C; and

C) an absorbent core positioned between said topsheet and said backsheet;

wherein the lotion is applied to the liquid pervious topsheet nonuniformly.

Sub C27
A3
14. (Amended) The disposable article of Claim 13 wherein the lotion is applied to the outer surface of the liquid pervious topsheet such that [certain areas] portions of the outer surface of the topsheet are not coated with lotion.

a4
~~27~~ (Amended) The disposable article of Claim 14 wherein lotion is transferred to the skin of a wearer that is contacted by the article during wear.

REMARKS

Claims 1-27 are pending before the Patent Office and stand rejected. Claims 1-17 are rejected under 35 U.S.C. 103 and Claims 14 and 27 are rejected under 35 U.S.C. 112, Second Paragraph.

Objection to The Specification

The Office Action contends that the application does not contain an abstract. Applicants respectfully point out that an abstract on a separate sheet was submitted with the application. To support Applicants' assertion, a copy of the abstract as originally submitted and a copy of the return postcard receipt, showing an abstract was received by the Patent Office, are submitted herewith.

The Office Action objected to the summary, stating that "[t]he summary is incomplete as it makes no mention of the lotion being applied nonuniformly." Accordingly, the Summary has been amended to include the limitation that lotion may be applied nonuniformly. Support for this amendment is found in Claim 1 as originally filed.

Claim Amendments

Claim 1 has been amended to more distinctly claim the lotion compositions comprising an emollient having a plastic or fluid consistency at 20°C and one or more immobilizing agents having a melting point of at least about 35°C. Support for this amendment is found on Page 4, Lines 1-20. Claims 14 and 27 have been amended to more clearly point out and distinctly claim the subject matter which Applicants consider as the invention. Support for the amendments is found on Page 25, Line 35 to Page 26, Line 6, and Page 13, Lines 6-9, respectively.

The above amendments introduce no new matters. Entry is believed to be proper and respectfully requested.

Rejection under 35 U.S.C. §103(a) over Dreier et al. in view of Buchalter, further in view of Duncan

The Office Action rejected Claims 1-27 under 35 U.S.C. §103(a) as being unpatentable over Dreier et al. (U.S. Patent No. 5,171,236) in view of Buchalter (U.S. Patent No. 3,896,807) further in view of Duncan (U.S. Patent No. 3,489,148). The Office Action asserted that “[i]t would have been obvious . . . to apply a lotion as taught by Buchalter, to a diaper as taught by Dreier in a nonuniform manner since Buchalter’s substance is not greasy and oily and Duncan teaches that a continuous coating is not needed, which will save money.”

Dreier teaches a diaper having a hydrophilic topsheet; when a hydrophobic material is used, it is treated to render it hydrophilic so that liquids will transfer through the topsheet more readily (Dreier 7:64-68). Buchalter teaches an article impregnated with a solid oil phase of a cream formulation which requires the addition of moisture to form a transferable cream (Buchalter 2:12-17). Duncan teaches a diaper having a hydrophobic and oleophobic topsheet wherein a portion of the topsheet is coated with a discontinuous film of an oily material (Duncan Claim 1). Duncan specifically teaches that the critical surface tension of the web must be sufficiently low with respect to the surface tension of the oily material and of waste fluids to prevent the drops of either from spreading on the web and the topsheet fibers may be coated with a fluorochemical to achieve the critical surface tension (Duncan 3:64-4:20). In other words, the oily material is applied to the topsheet in a substantially continuous manner (see Fig. 1 of Duncan) and the beading is due to the oleophobic nature of the topsheet which causes the formation of the discrete droplets 14a (see Fig 2 of Duncan).

Applicants respectfully submit that Duncan does not teach application of a lotion composition on an article in a nonuniform manner. As noted above, Duncan teaches continuous application and that the discrete droplets are formed due to the surface chemical properties of the oleophobic topsheet. Therefore, Applicants respectfully submit that a device combining the teachings of the Dreier, Duncan and Buchalter references would have the cream formulation applied in a uniform coating to a hydrophilic topsheet. Thus the combination fails to make Claim 1 as amended obvious.

Section 2143.01 of the MPEP states “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” Applicants submit that:

- the topsheet of Dreier cannot be combined with the topsheet of Duncan because (1) a topsheet material cannot be both hydrophilic (according to Dreier) and hydrophobic

(according to Duncan); and (2) the references specifically teach local treatment of the topsheet material to reach the different end products; and

- applying Buchalter's formulation as droplets on a hydrophilic topsheet of a Dreier diaper would not achieve a discontinuous, localized coating as taught by Duncan. This is so because Dreier's hydrophilic topsheet does not have the low critical surface tension required by Duncan, thus it likely would fail to hold the oily material in discrete droplets. In other words, the oily droplets on the Dreier topsheet would spread to form a continuous coating.

Therefore, Applicants submit that the combination of prior art references as suggested by the Office Action would change the principle of operation of the prior art invention, thus the references do not render the claimed invention *prima facie* obvious.

Applicants further submit that one must pick Dreier's hydrophilic topsheet as the substrate for Buchalter's oily material and at the same time, relying on Duncan's hydrophobic-oleophobic topsheet for its low critical surface tension, in order to arrive at a discontinuous coating of the topsheet. Thus, the Office Action has relied on improper hindsight reconstruction to pick and choose from the various teachings of the references. In that regard, the various teachings of the references simply cannot be combined in the manner suggested by the Office Action.

The MPEP also states, in Section 706.02(j), that the prior art references must have a reasonable expectation of success in order to establish a *prima facie* case of obviousness. First, Applicants submit, as discussed above, the combination of references cited by the Office Action will not successfully produce a diaper with a hydrophilic topsheet discontinuously coated with an oily material. Second, Buchalter teaches a dried, non-aqueous solid coating on an article which does not automatically or coincidentally transfer to the wearer's skin when worn; moisture is needed to activate the solids and thereby transform the solids into a transferable cream (Buchalter 2:12-17; 5:46-48). Since bodily discharges often comes in gushes, the skin of the wearer can be exposed to urine or feces before the cream of Buchalter reference is formed. Concurrently, the skin can become overhydrated before activation and transfer of the solids. Thus the wearer may get no skin benefits from the article made according to Buchalter's teaching. This is especially true when the wearer discharges bodily fluids into the article soon after the article is put on. Since Buchalter's teaching cannot be successfully applied to the present invention, combining Buchalter's dry solids with Dreier and Duncan would fail also.

Based on the discussion above, Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness based on the cited references. Reconsideration and withdrawal of rejection are respectfully requested.

Rejection under 35 U.S.C. §103(a) over Buchalter/Buell

The Office Action also rejected Claims 1, 11, 12, 29-31, 13-16 and 34-39, stating that “it would have been obvious. . . to coat Buell’s diaper with Buchalter’s lotion to prevent chafing or chapping of the skin.”

Section 706.02(j) of the MPEP lists three requirements for establishing a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. Applicants respectfully point out that:

- the combination of Buchalter and Buell does not teach or suggest the nonuniform application of a lotion composition on a hydrophilic topsheet of a diaper;
- Buchalter’s dry solids need moisture for activation and transferability (Buchalter 2:12-17; 5:46-48), there is no teaching of transfer without activation by moisture; and
- Buell’s diaper teaches a hydrophobic topsheet or no topsheet at all (Buell 6:19; 6:53-59) while the present invention teaches a topsheet (independent Claims 1 and 13).

Based on the above discussion, Applicants submit that the Office Action has failed to meet at least the second and the third requirements, therefore, has not established a *prima facie* case of obviousness based on the cited references. Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection of Claims 24 and 25

The Office Action further rejected Claims 24 and 25, contending that it is merely a matter of engineering design choice to apply the lotion in stripes wherein the immobilizing agent comprises a polyhydroxy fatty acid ester or a polyhydroxy fatty acid amide having the specific formulas as claimed or to use the immobilizing agent such as paraffin wax.

Applicants submit that the requirements of an immobilizing agent are clearly defined (17:18-18:14), thus the materials selection is not merely an engineering design choice. Applicants point out that:

- the above-identified immobilizing agents are solid at room temperature; thus they “lock” or localize the lotion composition on the substrate surface before use;
- the above-identified immobilizing agent melts at body temperature; thus they facilitates the transferability of the lotion to the wearer’s skin when worn;
- moreover, paraffin wax is hydrophobic; thus it contributes to the barrier property of the lotion composition and prevents the skin of the wearer from becoming overhydrated.

Based on these specific functions of an immobilizing agent, Applicants respectfully submit that these materials are not merely an engineering design choice.

Applicants further submit that, as discussed above, the Office Action has failed to establish obviousness regarding the broader claim, therefore, its reliance on references that allegedly teach a specific limitation of the dependent claim is improper. Applicants respectfully request reconsideration and withdrawal of rejection of Claims 24 and 25.

Nonstatutory Obviousness-Type Double Patenting Rejection over U.S. Patents to Roe in view of Duncan

The Office Action rejected Claims 1-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patents No. 5,607,760; 5,609,587; 5,643,588 and 5,635,191 in view of Duncan.

In response, Applicants will agree to submit a Terminal Disclaimer over the above identified Roe patents should the present application is considered in condition for allowance. This agreement to submit the Terminal Disclaimer is not an admission but is made merely to facilitate the prosecution of the present application.

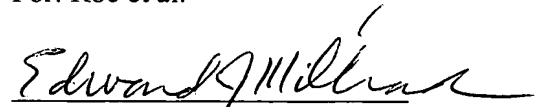
Rejection under 35 U.S.C. §112, Second Paragraph

The Office Action rejected Claims 14 and 27 under 35 U.S.C. §112, Second Paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. This rejection has been obviated by the amendments of Claims 14 and 27 herewith. Reconsideration and withdrawal of rejection are respectfully requested.

CONCLUSION

The above represents a complete response to the Office Action's rejection under the judicially created doctrine of obviousness-type double patenting and 35 U.S.C. §103(a) and §112, Second Paragraph. Applicants believe that this response places Claims 1-27 in condition for allowance. Reconsideration, withdrawal of rejections and Allowance are respectfully requested.

Respectfully submitted,
For: Roe et al.



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